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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/015,604 | 12/17/2001 | Shinichiro Hamada | 217398US2RD | 5932 |
| 22850 | 7590 | 06/16/2005 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. | | | | SMITH, PETER J |
| 1940 DUKE STREET | | | | |
| ALEXANDRIA, VA 22314 | | | | |
| ART UNIT | | PAPER NUMBER | | |
| | | 2176 | | |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/015,604 | HAMADA ET AL. | |
| | Examiner Peter J Smith | Art Unit 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 April 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,4-7,9-12,14 and 15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2,4-7,9-12,14 and 15 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 4/13/2005.
2. Claims 1, 2, 4-7, 9-12, 14, and 15 are pending in the case. Claims 1, 6, and 11 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 4, 6, 7, 9, 11, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al. (hereinafter “Miyagawa”), US 5,991,782 patented 11/23/1999.**

Regarding independent claims 1, 6, and 11, Miyagawa teaches extracting one or a plurality partial documents from the first documents according to locations of the first documents and ranges of the partial documents to be extracted, described by the specific markup language of the second document in col. 1 line 64 – col. 2 line 5, col. 2 lines 15-27, and col. 5 line 4 – col. 6 line 4. Miyagawa teaches that the documents may be coded for example in a structured document markup language such as SGML in col. 1 lines 33-38. Miyagawa teaches inserting the partial documents extracted by the extracting step into the second document according to insertion positions of the partial documents on the second document described by the specific markup language in the second document in col. 2 lines 36-64 and col. 6 line 6 – col. 7 line 9.

Miyagawa teaches converting the document structure of the second document according to ranges for which the document structure of the second document is to be converted including the partial documents inserted by the inserting step and an identification information of a file describing a conversion rule for converting the document structure into a desired document structure, which are described by the specific markup language in the second document in fig. 24-25, col. 2 line 6-14, col. 6 line 6 – col. 7 line 9, and col. 14 line 4 – col. 15 line 10.

Miyagawa does not specifically teach that the locations of the first documents are on the Internet. Miyagawa does not specifically teach the use of HTML or XML, but does teach that the documents may be encoded in the precursor format, SGML in col. 1 lines 33-39. One of ordinary skill in the art at the time of the invention would have had full knowledge of the use and implementation of HTML and XML documents referenced at locations on the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Miyagawa to have identified locations of the first documents on the Internet to have improved Miyagawa to have partialized and inserted portions of Internet documents to have created an aggregate second document. It would have been obvious and desirable to have combined Internet documents for the same motivations Miyagawa has to combine SGML documents in col. 1 lines 19-61.

Regarding dependent claims 2, 7, and 12, Miyagawa teaches wherein the extracting step and the inserting step use the second document which is described by using at least a tag for describing the locations of the first documents and the ranges of the partial documents to be extracted and specifying the insertion positions of the partial documents on the second document in col. 6 line 6 – col. 7 line 9. Miyagawa does not specifically teach that the locations of the first

documents are on the Internet. Miyagawa does not specifically teach the use of HTML or XML, but does teach that the documents may be encoded in the precursor format, SGML in col. 1 lines 33-39. One of ordinary skill in the art at the time of the invention would have had full knowledge of the use and implementation of HTML and XML documents referenced at locations on the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Miyagawa to have identified locations of the first documents on the Internet to have improved Miyagawa to have partialized and inserted portions of Internet documents to have created an aggregate second document. It would have been obvious and desirable to have combined Internet documents for the same motivations Miyagawa has to combine SGML documents in col. 1 lines 19-61.

Regarding dependent claims 4, 9, and 14, Miyagawa teaches wherein the converting step uses the second document which is described by using at least a tag for specifying the ranges for which the document structure of the second document is to be converted and describing the conversion rule in col. 6 line 6 – col. 7 line 9.

5. Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al. (hereinafter “Miyagawa”), US 5,991,782 patented 11/23/1999 as applied to claims 1, 6, and 11 above, and further in view of Lonnroth et al. (hereinafter “Lonnroth”), US 6,826,597 B1 provisional filed 3/17/1999.

Regarding dependent claims 5, 10, and 15, Miyagawa teaches wherein the extracting step uses a second document which is described in a structured document markup language such as SGML in col. 1 lines 33-39. Miyagawa does not teach wherein the second document is

described in Extensible Markup Language (XML), and when the first documents are not described in XML, the extracting step extracts the partial documents from the first documents after converting the first documents into a description format according to XML. Lonnroth does teach converting non-XML data into XML format in the col. 3 lines 14-31 and col. 10 line 63 – col. 11 line 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Miyagawa and Lonnroth to have created the claimed invention. It would have been obvious and desirable to have used XML to have described the second document as taught by Lonnroth in col. 3 lines 14-31. It would have been obvious and desirable to have used the conversion of Lonnroth so that the second document could have accessed Internet documents described in markup languages other than XML such as HTML as taught by Lonnroth in col. 1 lines 26-61.

Response to Arguments

6. Applicant's arguments, see page 7, filed 4/13/2005, with respect to the rejection of claims 11-15 under 35 USC 101 have been fully considered and are persuasive. The rejection of claims 11-15 under 35 USC 101 has been withdrawn in response to Applicant's amendment.

7. Applicant's arguments filed 4/13/2005 have been fully considered but they are not persuasive. Regarding Applicant's argument in pages 10 and 11 that Miyagawa et al. (hereinafter "Miyagawa") does not teach or suggest all the limitations of independent claims 1, 6, and 11, the Examiner respectfully disagrees. In addition to the relevant teachings in col. 6 line 6 – col. 7 line 9, the Examiner notes further support that Miyagawa teaches converting a document

structure of the second document according to ranges for which the document structure of the second document is to be converted including the partial documents inserted by the inserting step and an identification of a file describing a conversion rule for converting the document structure into a desired document structure, which are described by the specific markup language in the second document in fig. 24-25, col. 2 lines 6-14, and col. 14 line 4 – col. 15 line 10. Miyagawa teaches in col. 2 lines 6-14 that it allows a user to work with a plurality of document type definitions, or formats. Miyagawa teaches in col. 14 line 4 – col. 15 line 10 that the document type definition is converted for the document. Thus, the Examiner believes that Miyagawa does teach converting a document structure of the second document in both col. 6 line 6 – col. 7 line 9 and furthermore in fig. 24-25, col. 2 lines 6-14, and col. 14 line 4 – col. 15 line 10. Therefore, the Examiner maintains the rejection of claims 1, 6, and 11 as presently claimed.

Regarding Applicant's argument in page 11 that the combination of Miyagawa and Lonnroth et al. (hereinafter "Lonnroth") is the result of improper hindsight reconstruction, the Examiner respectfully disagrees. Lonnroth teaches converting a data source into XML in col. 3 lines 14-31. This conversion is the motivation for combining as pointed out by the Examiner in the rejection of claims 5, 10, and 15. Lonnroth teaches the desirability of converting a data source into XML and thus would have led one of ordinary skill in the art at the time of the invention to have implemented this change in Miyagawa. Therefore, the Examiner maintains the rejection of claims 5, 10, and 15 as presently claimed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
6/9/2005



**SANJIV SHAH
PRIMARY EXAMINER**